

REMARKS

I. Summary of Office Action

Claims 133-136 are pending in this application.

Claims 133-136 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Alexander et al. U.S. Patent No. 6,177,931.

II. Summary of Applicants' Reply

Applicants have amended claims 133-136 to more particularly define the invention. New claims 137-176 have been added.

The Examiner's claim rejections are respectfully traversed.

III. Summary of the Telephonic Interview

A telephonic interview was conducted on August 10, 2005. Applicants and applicants' representatives wish to thank the Examiner and his supervisor, Christopher C. Grant, for the courtesies extended during the interview.

During the telephonic interview, the Examiner and his supervisor took the position that program guide listings and program guide features (e.g., a theme guide) read on advertisements. The Examiner and his supervisor relied on a

dictionary definition of "advertisement" to support their position. Applicants believe that the Examiner relied on the Merriam-Webster's definition of advertisement which defines advertisement as "a public notice; especially one published in the press or over the air."¹ No agreement was reached as a result of the interview.

IV. Reply to the Rejection of Claims 133-136

Claims 133-136 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Alexander.

Applicants respectfully traverse this rejection.

Applicants' amended independent claims 133-136 are directed to systems, a method, and a machine-readable medium in which local and global advertisements are distributed to user equipment on which an interactive program guide is implemented. The local advertisements are designated for display in a particular geographic region. The interactive program guide displays the global advertisements, which can be selected by a user, on an interactive program guide display screen. In response to receiving the user selection of a global advertisement, the interactive program guide displays, on at least a portion of the interactive program guide display

¹ Merriam-Webster Online, <http://www.m-w.com/dictionary/advertisement>, 2005.

screen, a local advertisement that has been designated for display in the geographic region of the user equipment and that has content related to the selected global advertisement.

Applicants respectfully submit that, as set forth in detail below, the § 102 rejection is insufficient as a matter of law. First, the Examiner's interpretation of the term "advertisement" is unreasonable and inconsistent with applicants' specification. See MPEP § 2111. Second, in view of a reasonable interpretation of "advertisement", the prior art of record does not show each and every element of applicants' claims, either expressly or inherently. See MPEP § 2131.

A. The Examiner's Interpretation of
Advertisement is Unreasonable

During examination of a patent application, the pending claims must be "given their broadest reasonable interpretation consistent with the specification" (emphasis added). *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). During examination of this application, the Examiner interprets "global advertisements" to include "either [an] advertisement such as [a] video clip of [a] program displayed in Ad windows, or theme guide icons such as News, Sports, etc. [displayed in the interactive program guide screen]." Office Action, page 4, last two lines and page 5, line 1. In addition, the Examiner interprets

"local advertisements" to be "broadly met by customized messages of advertisements designated in a particular zip code and based upon video clips, program, [and] theme guides."

Office Action, page 5, lines 1-3. Furthermore, as discussed above in section III, the Examiner interprets advertisements to read on program guide listings and program guide features.

Applicants respectfully submit that the Examiner is giving the plain meaning of the term "advertisement" too much scope as to what it may cover, especially in the context of the specification and the ordinary and customary meaning associated with advertisements in the interactive program guide environment. To contend that a program listing or a program guide feature such as a theme guide is an advertisement is not consistent with the way advertisements are used in applicants' specification. Applicants submit that a program listing or a guide feature (e.g., a theme guide) is not an advertisement. Nothing in applicants' specification states otherwise. For example, applicants' specification specifies that interactive program guide advertisements may provide the user with useful information on various products and services, may be used to promote upcoming television programs, and may also be used to promote non-programming products and services. See, e.g., Specification page 2, lines 16-22, page 10, lines 26-30, page 14, lines 16-20,

page 17, line 1 - page 18, line 2. However, notwithstanding the foregoing, the Examiner reads global and local advertisement in accordance with a dictionary meaning that an advertisement is anything that provides notice. The definition of advertisement put forth by the Examiner encompasses practically any publication or display of any type of information, eliminating any distinction between advertisement and any other type of information. Using the Examiner's definition, everything broadcast on television is an advertisement; everything printed in every newspaper is an advertisement; everything printed in every book is an advertisement; everything on every web page, including the USPTO's, is an advertisement. Certainly, this is contrary to the ordinary meaning of advertisement.

Applicants are not asking the Examiner to read limitations of the specification into the claims, rather, applicants request that that the term "advertisement" be interpreted in view of the specification without unnecessarily importing limitations from the specification into the claims. "Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." *In re Marosi*, 710 F.2d 799, 218 USPQ 289, 292 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466

(CCPA 1976) (emphasis in original). Therefore, applicants respectfully request that the interpretation of the claims be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Turning first to the interpretation of program guide listings and advertisement in light of the specification, the specification itself treats advertisements and program guide listings as distinct. For example, "Main facility 46 contains a program guide database 48 for storing program guide information such as television program guide listings data, pay-per-view ordering information, television program promotional information, etc. Main facility 46 also contains an advertising database 50 for storing advertising information." Applicants' specification, page 9, lines 23-31. "During use of the program guide, television program listings, advertisements, and other information may be displayed on television 62." Applicants' specification, page 13, lines 10-12. "Program guide screen 95 contains program listings region 96, which contains a grid, list, or table of program listings. Program guide screen 95 also contains logos 98 and global panel advertisements 100." Applicants' specification, page 22, lines 7-10. "The upper program guide screen of FIG. 15 contains program listings region 112 and global banner

advertisements 114 and 116." Applicants' specification, page 22, line 30 through page 23, line 1. These examples from the specification show that that Examiner's interpretation of advertising as being synonymous with program guide listings is not reasonable in light of the specification.

Those of skill in the art would interpret these claims terms in the same way they are used in the specification. More specifically, those of skill in the art would not consider program listings, which may indicate when and on what channel a particular program is playing or will be playing, or program guide features such as theme guides, which may allow a user to organize program listings according to themes, to reasonably read on advertisements that are being displayed in the interactive program guide environment. To contend that program listings and program guide features read on advertisements is analogous to saying that any text, object, graphic or any other item displayed by an electronic program guide is an advertisement. Such an analogy is clearly unreasonable because every conceivable item that can displayed in the interactive program guide environment cannot reasonably be construed to be an advertisement. However, this is what the Examiner is contending.

Moreover, publications relating to the interactive television program guide environment distinguish

advertisements from other items (including, in particular, program listings) that may be displayed by a program guide. For example, www.BackChannelMedia.com defines electronic program guide advertisements² as advertisements that are "placed on the edges of listings or within electronic program guide listings." Here, BackChannelMedia defines advertisements with respect to program listings, thus clearly indicating that advertisements are not program listings. As another example, the European Broadcasting Union differentiates advertisements from program listings and program guide features. Section 9.1 of the Code of Practice for an Electronic Programme Guide (EPG)³ refers to an event area and a message area. The event area displays the program title and other parameters such as channel, time and date of transmission. In addition, the event area may display the results of a viewer's selection of a theme or other criteria. The message area can contain short or long information corresponding to a selected program or it can display messages, promotions of programs or advertisements. Here, as

² The definition for electronic program guide advertisement can be found at www.backchannelmedia.com/definitions3.html#e. A page from this Website is attached under Appendix A.

³ ETSI TR 101 288 Technical Report, Television Systems; Code of practice for an Electronic Programme Guide (EPG), V1.3.1, December 2002. This report is attached under Appendix B.

with BackMediaChannel, the Code refers to program guide listings and advertisements as separate and distinct terms of art.

Accordingly, in view of the foregoing, it is unreasonable for one skilled in the art to interpret the term advertisement to include program listings and program guide features such as theme guides.

B. The Prior Art of Record Does Not Show Each and Every Element of Independent Claims 133-136 when the term "Advertisement" is Reasonably Interpreted

1. The Video Clip and the Ad Window

The Examiner indicates that, in Alexander, a local advertisement is displayed in response to the selection of a program, or during a theme guide or a video clip. See Office Action, page 6, lines 1-11. Thus, it appears that the Examiner is contending that local advertisements are displayed when the user selects a program or a theme guide, or that local advertisements may be displayed as an overlay over a broadcast program or over a video clip in an Ad window. Indeed, in Alexander, local advertisements may be displayed as an overlay on a television program or a video clip in the ad window when an identifier associated with the local advertisement is triggered. See Alexander, column 32, lines 49-54. However, nowhere in the Office Action does the Examiner state that local advertisements are displayed in

response to a user selection of a video clip (e.g., an advertisement) being played in the Ad window.

2. Selection of a Theme Guide or Highlight of
Feature in the Program Guide

Alexander discloses that "the EPG displays different advertisements depending upon, e.g., which show the viewer has currently highlighted in the Grid Guide, what sport is highlighted in a sports data service, or what type of news is highlighted in a news service (international, local, etc.)." Alexander, column 34, lines 4-9. Based on the above and other disclosure in Alexander, the Examiner contends that applicants' claimed feature of displaying a local advertisement in response to a user selection of a global advertisement (which the Examiner contends can be a program or a theme guide) is shown. Applicants respectfully disagree and submit that for at least the reasons discussed above in Section IV.A, selecting a theme guide or highlighting a program is not that same as selecting a global advertisement. Accordingly, applicants cannot find a disclosure in Alexander that shows or suggests displaying a local advertisement that is designated for display in the particular geographic region of the user equipment when a global advertisement is selected by a user, wherein the displayed local advertisement has content related to the selected global advertisement.

Therefore, in view of the foregoing reasons that the Examiner is unreasonably interpreting the term "advertisement" and that the prior art of record does not show each and every element of applicants' independent claims 133-136, applicants respectfully submit that independent claims 133-136 are allowable.

V. New Claims

New claims 137-176 have been added. New claims 137-176 are allowable for at least the reason they depend from independent claims 133-136.

VI. Conclusion

Applicants respectfully submit that claims 133-176 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



Andrew Van Court
Registration No. 48,506
Michael J. Chasan
Registration No. 54,026
Agents for Applicants
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000